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| APPLICATION NO.       |         | FILING DATE     | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |  |  |
|-----------------------|---------|-----------------|-------------------------|---------------------|------------------|--|--|
| 10/735,322 12/12/2003 |         | Chih-Lung Chang | 3304.2.101              | 6011                |                  |  |  |
| 21552                 | 7590    | 02/04/2005      |                         | EXAM                | EXAMINER         |  |  |
| MADSON                | & MET   | CALF            | LORENGO                 | LORENGO, JERRY A    |                  |  |  |
| GATEWAY<br>SUITE 900  | TOWER   | R WEST          | ART UNIT                | PAPER NUMBER        |                  |  |  |
| 15 WEST S             | OUTH T  | EMPLE           | 1734                    | 1734                |                  |  |  |
| SALT LAK              | E CITY, | UT 84101        | DATE MAILED: 02/04/2005 |                     |                  |  |  |

Please find below and/or attached an Office communication concerning this application or proceeding.

| Application No.   Applicant(s)   |   |   |  |   |  |              |  |  |  |  |
|--|---|---|--|---|--|--------------|--|--|--|--|
| Examiner Jerry A. Lorengo  - The MALING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply  A. SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MALIND DATE OF THIS COMMUNICATION.  Edenations of time may be available under the proteions of 37 CFR 1.136(a). In on event, however, may a risply be timely filled  If NO period for reply is operiod advise, the maximum stabulary period will apply and will expire SIX (6) MONTH's from the mailing date of this communication.  If NO period for reply is operiod advise, the maximum stabulary period will apply and will expire SIX (6) MONTH's from the mailing date of this communication.  If NO period for reply is operiod advise, the maximum stabulary period will apply and will expire SIX (6) MONTH's from the mailing date of this communication.  If NO period for reply is operiod advise, the mailing date of this communication, which is the period of the communication.  If NO period for reply specified advise, the maximum stabulary period will apply and will expire SIX (6) MONTH's from the mailing date of this communication.  If NO period for reply specified advise, the mailing date of this communication, which is the mailing date of this communication.  If NO period for reply specified advise, the stable symminum of the period of the communication.  If NO period for reply is upported by the SIX (1) Month's from the mailing date of this communication.  If NO period for reply specified and set of the communication.  If NO period for reply specified and set of the communication.  If NO period for reply specified and set of the communication.  If NO period for reply specified and set of the communication.  If NO period for reply specified and set of the communication.  If NO period for reply specified and set of the mailing date of the communication.  If NO period for reply specified and set of the period the communication.  If NO period for reply specified date of the reply specified and set of the peri |   |   | Applica  | ation No.   | Applicant(s)   |              |  |  |  |  |
| Jerry A. Lorengo   1734  | 0.00  | 10/735  | ,322   | CHANG ET AL.  |  |              |  |  |  |  |
| The MALING DATE of this communication appears on the cover sheet with the correspondence address — Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MALILING DATE OF THIS COMMUNICATION.  Extensions of term may be available under the provisions of 3 CFR 1.136(a). In no event, however, may a reply be timely filled  ### the period for energy to specified above it less than lithin (30) stays, a reply within the statutory minimum of thiny (30) days, will be considered timely.  ### the period for reply specified above, the maximum statutory period village part will supplies (4) MONTHS from the malting date of this communication for the period for reply specified above, the maximum statutory period village part will supplies (4) MONTHS from the malting date of this communication (s) filled on   | Office A  | Action Summary  | Examir   | ier   | Art Unit   |              |  |  |  |  |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  Ederwiche of three may be available under the provisions of 37 CFR 1.35(a). In ne event, however, may a reply be timely filled.  Ederwiche of three may be available under the provisions of 37 CFR 1.35(a). In ne event, however, may a reply be timely filled.  Ederwiche of three may be available under the provisions of 37 CFR 1.35(b). In ne event, however, may a reply be timely filled.  Ederwiched for reply is specified above, the maximum statutory period will suphy and will expire SIX (b) MONTH'S from the making date of this communication for reply replicated state then from among the time has been selected with expire state then from among the time has been selected with expire state then from among the time has been selected with expire state then from among the time has been selected by the Office state then from among the time has been selected by the Cine state then from among the time has been selected and selected to selected to selected to for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s)   |   |   |  |   |  |              |  |  |  |  |
| THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of min may be available under the provisions of 3 CPR 1.136(p). In no event, however, may a reply be timely filed of the CR (R) MONTISE from the mailing date of this communication.  - It NO period for reply is specified above, the maximum statutory period vallegy that will serve SK (R) MONTISE from the mailing date of this communication.  - It NO period for reply is specified above, the maximum statutory period vallegy that will serve SK (R) MONTISE from the mailing date of this communication, even if timely (R) (A) days will be considered limely.  - It NO period for reply is specified above, the maximum statutory period vallegy that will serve SK (R) MONTISE from the mailing date of this communication, even if timely filed, may reduce any comment puter term adjustment. See 37 CFR 1.794(b).  - Status  1) Responsive to communication(s) filed on  |   | G DATE of this commu  | nication appears on t  | he cover sheet with the   | he correspondence add  | dress        |  |  |  |  |
| 1) Responsive to communication(s) filed on   | THE MAILING DA  - Extensions of time may after SIX (6) MONTHS f  - If the period for reply sp  - If NO period for reply is  - Failure to reply within th Any reply received by th | TE OF THIS COMMUN<br>be available under the provision<br>rom the mailing date of this com<br>ecified above is less than thirty (<br>specified above, the maximum s<br>e set or extended period for repl<br>e Office later than three months | IICATION. s of 37 CFR 1.136(a). In no munication. 30) days, a reply within the statutory period will apply and y will, by statute, cause the a | event, however, may a reply b<br>statutory minimum of thirty (30<br>d will expire SIX (6) MONTHS<br>application to become ABAND | be timely filed  ) days will be considered timely from the mailing date of this co | mmunication. |  |  |  |  |
| 2a)  This action is FINAL. 2b)  This action is non-final.  3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4)  Claim(s) 1-11 is/are pending in the application. 4a) Of the above claim(s)  is/are withdrawn from consideration.  5)  Claim(s)  is/are allowed. 6)  Claim(s)  is/are objected to. 8)  Claim(s)  1-11 are subject to restriction and/or election requirement.  Application Papers  9)  The specification is objected to by the Examiner. 10)  The drawing(s) filed on  is/are: a) accepted or b)  objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a)  All b)  Some * c)  None of: 1.  Certified copies of the priority documents have been received in Application No. 3  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  *See the attached detailed Office action for a list of the certified copies not received.  Attachment(s)  1)  Notice of References Cited (PTO-892)   Solve of Toritsperson's Patent Drawing Review (PTO-948)   Solve of Internation Disclosure Statement(s) (PTO-1449 or PTO/58/08)   | Status  |   |  |   |  |              |  |  |  |  |
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| 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 4) Interview Summary (PTO-413) Paper No(s)/Mail Date Notice of Informal Patent Application (PTO-152)  | 12) Acknowledgn  a) All b) S  1. Certifie  2. Certifie  3. Copies   | nent is made of a claim Some * c) None of: ed copies of the priority s of the certified copies ation from the Internation   | or documents have be<br>or documents have be<br>of the priority documental<br>onal Bureau (PCT R   | een received.<br>een received in Appli<br>ments have been rec<br>kule 17.2(a)).   | cation No<br>eived in this National  | Stage        |  |  |  |  |
| 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date  Notice of Informal Patent Application (PTO-152)  | Attachment(s)   |   |  |   |  |              |  |  |  |  |
| 7,   | 2) 🔲 Notice of Draftspersor   | n's Patent Drawing Review (<br>Statement(s) (PTO-1449 o   |  | Paper No(s)/Ma  | ail Date   | -152)        |  |  |  |  |

Application/Control Number: 10/735,322

Art Unit: 1734

## **DETAILED ACTION**

(1)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-5, drawn to a method for applying an image onto an article having a light transmissible surface, classified in class 156, subclass 230.
- II. Claims 6-11, drawn to a use of an image-transfer medium, classified in class 156, subclass 235.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination, respectively. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require that the article have a light transmissible surface. The subcombination has separate utility such as forming decorative patterns on light transmissible substrates such as windows, light boxes, view screens, etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Evan Witt on February 2, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made as Mr. Witt requested that the Examiner issue the restriction requirement as a written communication.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1734

(2)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lorengo, Primary Examiner

AU 1734 / Rebruary 2, 2005